

U. S. PTO Customer No. 25280

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REMARKS

Claims 1-161 were pending in the application. Claims 1-11, 17-21, 24, 25, 27, 31-139, 141-143, and 147-161 have been canceled. The remaining claims 12-16, 22, 23, 26, 28-30, 140, and 144-146 have been amended. No claims have been added. Thus claims 12-16, 22, 23, 26, 28-30, 140, and 144-146 remain subject to continued examination. Each of these claims is believed to be in condition for allowance. Accordingly, an action to that effect is requested at this time.

Formal Rejections:

Claims 1-102, 110-138 and 150-161 were previously rejected under 35 U.S.C. 112 second paragraph due to the use of relative terms such as "low face weight", "light weight" and "low weight primary carpet." Applicants have attempted to remove such terms and/or to include definite values as modifying language so as to eliminate any ambiguity. Thus, reconsideration and withdrawal of all outstanding 112 rejections is requested at this time.

Anticipation Rejections:

Various claims were rejected as being anticipated by U.S. Patent 4,522,857 to Higgins or U.S. Patent 5,540,968 to Higgins. However, all remaining claims either were never subject to the prior anticipation rejections or have been amended to depend from claim 12 which was not subject to the anticipation rejection. Thus, it is respectfully submitted that all anticipation rejections are obviated. Reconsideration and withdrawal of all anticipation rejections is therefore requested.

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Obviousness Rejections:

Claim 12 (from which claims 13-16, 22, 23, 26 and 28-30 now depend) was previously rejected under 35 U.S.C. 103(a) as being obvious over Higgins '857 or Higgins '968 in view of EP 048 986 to Porter et al. Continued rejection on this basis is respectfully traversed and reconsideration is requested at this time.

Independent claim 12 (and thus all claims depending therefrom) recites:

A carpet tile, comprising a primary carpet and a cushion layer wherein the primary carpet has a face weight less than or equal to about 15 oz/yd² and wherein the cushion layer has a polymer weight of about 2.72 – 8.24 oz/yd².

Thus, the claims require the following three elements:

1. A carpet tile
2. The primary carpet has a face weight less than or equal to about 15 oz/yd²
3. The cushion layer has a polymer weight of about 2.72 – 8.24 oz/yd²

As best understood, this combination of features does not appear to be taught or suggested by the art of record. Thus, the art does not appear to support a *prima facie* case of obviousness.

The Office Action relies upon Porter et al. as teaching face weights of less than 15 oz/yd² and concludes that it would be obvious to use such face weights (presumably in the files of the

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Higgins references) to produce a carpet product. Applicants respectfully disagree with this conclusion since the teaching in Porter et al. is merely an experimental example and appears to be directed exclusively to broadloom rather than carpet tile. Thus, the rejection appears to be applying an impermissible "obvious to try" rationale based on hindsight gleaned from the present application.

Even if it were considered obvious to use a lightweight primary carpet, there is no support within the art of record for combining such lightweight primary carpets with a cushion layer having a polymer weight of about 2.72 – 8.24 oz/yd² in a carpet tile as presently claimed. To the contrary, the specific teachings in Higgins '857 as well as in Porter et al. would lead one to believe that substantially higher cushion weights are required. This is particularly true when lightweight carpet fabrics are used. Specifically, in the examples of Porter et al. which the Examiner relies upon, the lightweight fabric is paired exclusively with foams applied at extremely high weights in excess of 40 oz/yd². Thus, the clear teaching to be derived from Porter et al. is that lightweight carpet fabrics should be paired with high weight foam. Moreover, the Higgins '857 indicates that in a carpet tile, higher weight foams are desirable. In particular, Higgins '857 teaches a lower limit of 10 oz/yd² for foam in a carpet tile. Of course, this is substantially higher than the upper limit of 8.24 oz./yd² presently claimed.

It is fundamental that the art must be considered in its entirety –including portions that would lead away from the claimed invention. In the present case, the teachings of the references are overwhelmingly against the present invention. Thus, any continued rejection of claim 12 or any claim depending therefrom appears to be based only on the impermissible basis of what one of

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skill in the art might have done or could have done rather than on the basis of what the prior art would have suggested.

Claims 140 and 144-146 stand rejected under 35 U.S.C. 103(a) as being obvious over Higgins '857 or Higgins '968 in view of Porter et al. Continued rejection on this basis is respectfully traversed and reconsideration is requested. The obviousness rejection portion of the Office Action (paragraphs 8-13) does not provide any rationale supporting a conclusion that the claimed features of these claims are obvious. The mere statement that a set of claims is obvious is inadequate to support a rejection. At least some explanation must be provided which includes an evaluation of all claim elements. Absent such an explanation, Applicants are left to speculate as to the why the features are considered obvious. Accordingly, if the rejection is to be maintained, Applicant respectfully requests the Examiner to provide the required explanation so as to permit a response. In order to progress prosecution, Applicants at this time note that if the Examiner seeks to rely on an inherency argument to support a continued rejection of claims 140 and 144-146, it is insufficient for the Examiner to argue that the claimed characteristic may occur or be present. Rather, the Examiner must establish that the claimed characteristic would necessarily be present. See, MPEP section 2112.

In view of the fact that the obviousness rejection fails to provide the required analysis of the outstanding rejection of claims 140 and 144-146, it is respectfully believed that the rejections should be withdrawn. If the rejections are to be maintained, they should not be made final since the amendments to those claims have not added subject matter and Applicants have had no opportunity to address the Examiner's rationale for rejection.

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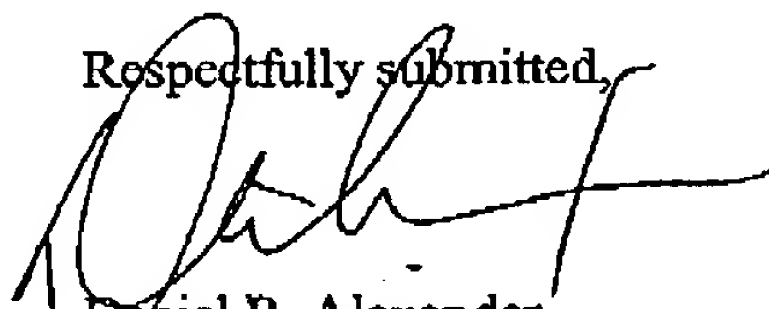
CONCLUSION:

In light of the claim amendments and arguments set forth above, Applicants respectfully submit that all claims are in condition for allowance at this time. While an attempt has been made to address all outstanding issues, to any extent that one or more issues remain, the undersigned respectfully requests a telephone conference to resolve such issues.

A three (3) month extension of time accompanies this amendment. Please charge any fees or credit any overpayment in connection with this Amendment (including any extension fees) to Deposit Account 04-0500.

March 16, 2004

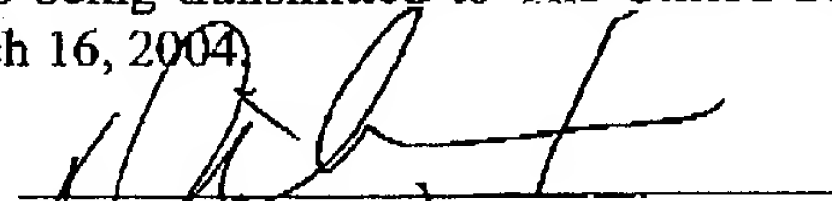
Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to The United States Patent and Trademark Office at 703-872-9306 on March 16, 2004.



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